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By

Krishna G. Banerjee

(Signature of person mailing)
Krishna G. Banerjee

(Typed or printed name of person)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: YANG, BINGWEI V. :

APPLICATION SERIAL NO.: 09/844,646 : Examiner: Seaman, D Margaret

FILING DATE: APRIL 27, 2001 : Group Art Unit: 1625

TITLE: SUBSTITUTED QUINOLIN-2-ONE:
DERIVATIVES USEFUL AS
ANTIPROLIFERATIVE AGENTS

Commissioner for Patents
Alexandria, VA 22313

RECEIVED

FEB 8 - 2004

TECH

Sir:

RESPONSE TO SEPTEMBER 26, 2003 OFFICE ACTION

This response is submitted in response to the Office Action in the above-identified application that was mailed to Applicants' attorney on September 26, 2003. A response to the September 26, 2003 Action was due three (3) months from its mailing date, i.e., December 26, 2003. Submitted with this response is a Petition for an Extension of Time requesting that the period for responding to the Action be extended by one (1) month so that it does not expire until January 26, 2003. Therefore, this response is timely filed. Applicants respectfully request reconsideration of the application.

Rejection under 35 U.S.C. §102(b) and §103(a)

On pages 2-3 of the Action, claims 1-11 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over End (WO 98/55124 and U.S. Patent No. 6365600) and Venet (WO 97/16443, WO 97/21701, and U.S. Patent Nos. 5,968,952; 6,037,350; and 6,169,096). The Examiner asserts that Venet and End both teach

imidazol-5-ylmethyl-2-quinolinone derivatives as inhibitors of cell proliferation and their pharmaceutical compositions and methods of use.

Applicant respectfully disagrees with the Examiner's position that the cited references anticipate or render obvious the presently claimed invention.

In the presently claimed compounds, the substituent "Z" refers to an aromatic 4 or 10 membered **heterocyclic** group, substituted with 1 to 4 R³ substituents. None of the Venet and End references disclose or suggest imidazol-5-ylmethyl-2-quinolinone derivatives wherein the substituent Z is a substituted or unsubstituted 4 to 10 membered heterocyclic group, as presently claimed. Applicants respectfully submit that the cited Venet and End references refer to quinoline derivatives wherein the substituents corresponding to presently recited "Z" are either substituted or unsubstituted phenyl groups, not aromatic heterocyclic groups.. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP 2131. In the present case, none of the compounds disclosed in Venet and/or End anticipate the presently claimed compounds. It is respectfully submitted that since neither of the cited references teaches each and every element of the claimed invention, neither reference anticipates the present invention.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 2142. The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). MPEP 2142.

In the present case, the Examiner has not provided any rational how the cited references alone or in combination would render obvious the presently claimed invention. Furthermore, it is the Applicant's position that there is no motivation, based on the disclosure of the Venet and/or End references, for a person of ordinary skill in the art to arrive at the presently claimed invention. And, even if the Venet and End references were combined, they do not lead to the presently claimed invention. Accordingly, the presently claimed invention is not rendered obvious by the disclosure of the Venet and/or End references.

In view of the above discussion, Applicant respectfully requests the Examiner to withdraw the present rejection, and allow pending claims 1-11.

CONCLUSION

Applicants respectfully request prompt consideration of the pending claims and early allowance of the application.

If the Examiner wishes to comment or discuss any aspect of this application or response, applicants' undersigned attorney invites the Examiner to call him at the telephone number provided below.

Date: January 26, 2004

Pfizer, Inc
Patent Department, 5th Floor
150 East 42nd Street
New York, NY 10017-5612
(212) 733-5310

Respectfully submitted,

Krishna G. Banerjee
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Reg. No. 43,317

FEE TRANSMITTAL
for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small status. See 37 CFR 1.27

Total Amount of Payment **(\$)**110.00

Complete If Known

Application Number 09/844,646
Filing Date APRIL 27, 2001
First Named Inventor BINGWEI V. YANG
Examiner Name D. Margaret Seaman
Art Unit 1625
Attorney Docket No. PC10839A

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☐ Deposit Account:

Deposit
Account
Number

16-1445

Deposit
Account
Name

Pfizer Inc

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) during the pendency of this application

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Fee (\$)	Small Entity Fee Code	Fee (\$)	Fee Description	Fee Paid
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) **(\$)**

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

	Extra Claims	Fee from below	Fee Paid
Total Claims <input type="text"/> - 20** = <input type="text"/>	X	<input type="text"/>	= <input type="text"/>
Independent Claims <input type="text"/> - 3** = <input type="text"/>	X	<input type="text"/>	= <input type="text"/>
Multiple Dependent <input type="text"/>			= <input type="text"/>

** or number previously paid, if greater; For Reissues, see below

Large Entity Fee Code	Fee (\$)	Small Entity Fee Code	Fee (\$)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	**Reissue independent claims over original patent
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) **(\$)**

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Fee (\$)	Small Entity Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late fee or oath	
1052	50	2052	25	Surcharge-late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	110.00
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	400	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)	
1801	770	2801	365	Request for Continued Examination (RCE)	
1806	180	1806	180	Submission of Information Disclosure Statement	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	

Other Fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) **(\$)** 110.00

SUBMITTED BY

Name (Printed/Type) KRISHNA G. BANERJEE

Signature

Krishna G. Banerjee

Date

1/26/04

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FEE TRANSMITTAL PTO SB 17.DOT 10/03